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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,931	08/02/2001	Debra L. Shade	1812 US	8818
26356	7590	12/30/2004		
ALCON RESEARCH, LTD. R&D COUNSEL, Q-148 6201 SOUTH FREEWAY FORT WORTH, TX 76134-2099			EXAMINER HAYES, ROBERT CLINTON	
			ART UNIT	PAPER NUMBER
			1647	

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/920,931

Applicant(s)

SHADE ET AL.

Examiner

Robert C. Hayes, Ph.D.

Art Unit

1647

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 November 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 1-14.Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on _____ is a) ☒ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet

PCW

Continuation of 5 and 7. does NOT place the application in condition for allowance because: no where is it recited in the claims, nor described within the specification, what the structure of ADNF-14 or ADNF-9 entails, as previously made of record (i.e., as it relates to the still pending enablement rejection made of record). For example, Brenneman is not a US Patent nor US patent application for possible incorporation by reference. Nor has this reference even been improperly indicated to be "incorporated by reference" in the instant specification. See MPEP 608.1(p) and In re Seversky, 177 USPQ 144 (CCPA 1973). Likewise, because neither the recited claims nor the specification provide any closed-ended definition and definable structure for ADNF-14 or -9 that distinguishes the teachings of Gozes from that claimed, the rejection under 102(b) remains proper. Note that although Applicants are correct that they previously stated "Gozes discusses the use of ADNF-III, also known as ADNP" (after magnifying the scanned image in the previous response), the issue does not change that Gozes anticipates the currently claimed invention, for the reasons made of record. Therefore, Applicants' arguments are not persuasive, for the reasons previously made of record .

Continuation of 10. Other: Applicant is reminded of the Rules of "decorum and courtesy" (Rule 1.3) in conducting business before the U.S. Patent and Trademark Office, as it relates to the comment at the bottom of page 7 of the response concerning "[a]nyone with training in the English language would clearly understand..." .



ROBERT C. HAYES, PH.D.
PATENT EXAMINER